

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

OF: BRATZ ET AL.

SERIAL NO. 10/043,241

FILED: JANUARY 14, 2002

FOR: SOLID MIXTURES BASED ON SULFONYLUREAS AND ADJUVANTS

DOCKET No.: 42044-CONT

CONFIRMATION No.: 1890

GROUP ART UNIT: 1612

EXAMINER: S. N. QAZI

Honorable Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. §1.181

Sir:

Applicants hereby petition to the Honorable Commissioner to withdraw from final rejection the above-identified pending application and to require the Examiner to issue an Office action which is based on the totality of the record.

On the facts which are summarized in the following, applicants respectfully urge that the final Office action which issued on November 23, 2009, failed to consider the totality of the record, and thus is inconsistent with established procedures and law.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

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SUMMARY OF MATERIAL FACTS:

1. The application was filed on January 14, 2002, as a continuation application of application Serial No. 09/341,524, which in turn was filed on July 13, 1999, under 35 U.S.C. §371 as a U.S. national stage of PCT/EP98/00201, filed on January 29, 1998.
2. On December 31, 2007, a final Office action issued rejecting then pending Claims 10 to 17 and 19 to 21 under 35 U.S.C. §101, and then pending Claims 10 to 17 and 19 to 23 under 35 U.S.C. §103.¹⁾
3. On April 30, 2008, applicants timely submitted a Request for Continued Examination including a request and fee for one month extension of time, a request and fee for suspension of action under 37 C.F.R. §1.103(c), as well as a submission and amendment addressing the final Office action. Along with the request, applicants presented Claims 10 to 17, 19, 20 and 22 to 31 in their current version for examination.
4. On August 21, 2008, an election and restriction requirement issued and applicants timely replied on October 21, 2008, including a request and fee for one month extension of time.
5. On February 12, 2009, a non-final Office action issued objecting to previous specification amendments, and rejecting all pending claims under the written description and the enablement requirement of 35 U.S.C. §112, ¶1, and under 35 U.S.C. §103, and withdrawing the rejection under 35 U.S.C. §101.
6. On July 10, 2009, applicants timely submitted a reply including a request and fee for two month extensions of time, a substitute specification addressing the specification objection, and arguments addressing the rejections under 35 U.S.C. §112, ¶1, and under 35 U.S.C. §103.
7. On November 23, 2009, a final Office action issued essentially verbatim repeating the specification objection, and the rejections under 35 U.S.C. §112, ¶1, and under 35 U.S.C. §103, as well as the withdrawal of the rejection under 35 U.S.C. §101.
8. This Petition follows. No Notice of Appeal has as yet been filed in reply to the final Office action of November 23, 2009.

ISSUE TO BE REVIEWED:

Whether the Office action of November 23, 2009, was properly based on the complete record

1) The prosecution history preceding the final Office action of December 31, 2007, is deemed to be subsidiary to the issue presented in the present Petition, and therefore is omitted in the summary of material facts.

and meets the provisions of established procedures and law, and thus whether the Office action was properly made final.

MEMORANDUM:

In all material aspects, the Office action of November 23, 2009, is a copy of the arguments and comments made in the Office action of February 12, 2009, with only minor and immaterial changes:

- The text on page 4, line 1, to page 25, line 8, is identical with page 4, line 6, to the bottom of page 25, of the Office action of February 12, 2009;
- With the exception of (a) line 10 on page 25, (b) line 15 on page 26, and (c) lines 4 and 5 on page 28, the text on page 25, line 10, to page 28, line 12, is identical with page page 26, line 5, to page 29, line 7, of the Office action of February 12, 2009;
 - (a) The sentence “*Applicants [sic] arguments are not found persuasive.*” was added relative to the Office action of February 10, 2009;
 - (b) The sentence “*The data does not commensurate with the scope of the claims.*” was added relative to the Office action of February 10, 2009;
 - (c) The sequences “***” were removed relative to the Office action of February 10, 2009;
- The text on page 28, lines 13 to 16, is identical with page 26, lines 1 to 4, of the Office action of February 12, 2009.

In particular, and apart from the differences specified in (a) to (c):

- the Office action of November 23, 2009, does not acknowledge, or comment on, the substitute specification and applicants’ detailed comments regarding the specification objections which were submitted with applicants’ reply of July 10, 2009;
- the Office action of November 23, 2009, does not acknowledge, or comment on, applicants’ detailed comments regarding the written description and the enablement requirement of 35 U.S.C. §112, ¶1, which were submitted with applicants’ reply of July 10, 2009; and
- the Office action of November 23, 2009, does not acknowledge, or comment on, applicants’ supplemental comments regarding the rejection under 35 U.S.C. §103(a), which were submitted with applicants’ reply of July 10, 2009.

35 U.S.C. §132(a) mandates that that an application shall be reexamined if an applicant, after receiving a notice of rejections or objections or requirements, persists in his claim for a patent, and

states: “Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging the propriety of continuing the prosecution of his application,” (emphasis added). Correspondingly, 37 C.F.R. §1.104(b), second sentence, provides: “The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, ..., to judge the propriety of continuing the prosecution.” The Office action of November 23, 2009, is not deemed to comply with the mandates of 35 U.S.C. §132(a) and 37 C.F.R. §1.104(b) for lack of acknowledgement, or comments on, the presentations and arguments which were made in applicants’ paper of July 10, 2009. Especially, the Office action of November 23, 2009, fails to contain information which would allow applicants to judge the propriety of continuing the prosecution of the application. Also, MPEP §707.07(f) explains: “In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application,” (emphasis added). By merely copying the arguments presented in the Office action of February 12, 2009, without addressing the applicants’ presentations and arguments made in their reply of July 10, 2009, the Office action of November 23, 2009, cannot be deemed to provide a clear explanation of why the objection and the rejections made in the Office action of February 12, 2009, were maintained.

Further, MPEP §706.07 explains: “The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal” (emphasis added), and: “In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection” (emphasis added). A mere copy of the arguments presented in the Office action of February 12, 2009, without addressing the applicants’ presentations and arguments made in their reply of July 10, 2009, cannot be deemed suited to clearly develop the grounds of rejection to such an extent that applicants may readily judge the advisability of an appeal.

Applicants appreciate that neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution.²⁾ However: “While the rules no longer give to an appli-

2) MPEP §706.07, citing *Ex parte Hoogendam*, 1939 C.D. 3, 499 O.G.3, 40 USPQ 389 (Comm’r Pat. 1939).

cant the right to 'amend as often as the examiner presents new references or reasons for rejection,' present practice does not sanction hasty and ill-considered final rejections.'”³⁾

CONCLUSION:

Applicants therefore respectfully petition that the finality of the Office action mailed on November 23, 2009, be withdrawn, and that the Examiner be required to issue an Office action which is based on the totality of the record, i.e., which duly addresses the presentations and arguments made by applicants in their paper of July 10, 2009, including such information as may be useful to applicants to judge the propriety of continuing the prosecution of the application. Favorable action is respectfully solicited.

3) MPEP §706.07.